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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/848,809

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Steven C. Black

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EXAMINER

SENSENIG, SHAUN D

ART UNIT

PAPER NUMBER

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/848,809	<b>Applicant(s)</b> BLACK ET AL.	
	<b>Examiner</b> Shaun Sensenig	<b>Art Unit</b> 4176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 23-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20041905 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040805 and 20061218</u> .                                   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11 and 15-22, drawn to automated electrical financial or business practice or management system, classified in class 705, subclass 1.
  - II. Claims 12-14, drawn to an automated electrical financial or business practice or management system for allocating resources or scheduling for an administrative function, classified in class 705, subclass 8.
  - III. Claims 23-28, drawn to an automated electrical financial or business practice or management system for accounting, classified in class 705, subclass 30.
2. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as recruiting employees and subcombination III has separate utility such as administering employee compensations. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the

allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

4. During a telephone conversation with Mr. Peter Malen (Reg. No. 45576), attorney for the applicant, on May 21, 2008, a provisional election was made without traverse to prosecute the invention of Invention I, claims 1-11 and 15-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-14 and 23-28 are hereby withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) is acknowledged, however, applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In this case, the disclosure of the prior-filed application, Application No. 60/474,044, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 15-18 of this application. Therefore, claims 15-18 have not been accorded the benefit of the earlier filing date.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 3-6, and 11** are rejected under 35 U.S.C. 102(b) as being anticipated by Your Employment Risk Solutions, Inc. (retrieved from the Wayback Machine as of May 24, 2002) (hereafter referred to as YERS).

8. In regards to **Claim 1**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, the method comprising:

(a) generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria; (page 1, ¶ 3)

(b) making the plurality of human resources compliance forms available to a client and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client; (page 1, ¶ 3)

(c) updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria; and (page 2, ¶ 1)

(d) making the updated human resources compliance form available to the client. (page 1, ¶ 3 and page 2, ¶ 1)

9. In regards to **Claim 3**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee hiring. (page 1, ¶ 3 and page 3, “The Hiring Process”)

10. In regards to **Claim 4**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee termination. (page 1, ¶ 3 and page 1, ¶ 3 and page 4, “Termination of Employees”)

11. In regards to **Claim 5**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human

resources compliance forms correspond to employee training. (page 1, ¶ 3 and page “Labor Relations”)

12. In regards to **Claim 6**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the predetermined legal criteria and human resources compliance forms correspond to employee compensation. (page 4, “Company Pay Practices”)

13. In regards to **Claim 7**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data corresponds to at least one of a client characteristic and an employee of the client. (page 1, ¶ 3)

14. In regards to **Claim 11**, YERS discloses:

A computer program product for use in a client-server environment, the computer program product comprising one or more computer-readable media having computer-executable instructions for implementing a method for facilitating the management of human resources compliance efforts, the method comprising:

(a) generating a plurality of human resources compliance forms that substantially conform to predetermined legal criteria, (page 1, ¶ 3)

(b) making the plurality of human resources compliance forms available to a client and in an order that is dynamically controlled at least in part by the legal criteria and status data corresponding to the client; (page 1, ¶ 3)



(c) updating, as required, at least one of the plurality of human resources compliance forms to conform with a change in the legal criteria; (page 2, ¶ 1) and

(d) making the updated human resources compliance form available to the client. (page 1, ¶ 3 and page 2, ¶ 1)

15. **Claims 15-18** are rejected under 35 U.S.C. 102 (e) as being anticipated by Habichler et al. (Pub. No. US 2007/0203713 A1) (Hereafter referred to as Habichler).

16. In regards to **Claim 15**, YERS discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, the user interface comprising:

(a) a first interface portion configured to provide a client access to a plurality of forms for use in a human resources process, wherein client access to the forms is controlled at least in part by legal criteria governing the human resources process, and wherein at least one of the forms is dynamically updated by the server to reflect changes in the legal criteria; ([0075])

(b) a second interface portion configured to reflect changes in the legal criteria; ([0075]) and

(c) a third interface portion configured to reflect status data of employees working for the client, the at least one updated form being customized for at least one of the employees based on the status of the at least one employee. ([0075])

17. In regards to **Claim 16**, YERS discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, wherein client access includes the ability of the client to modify data used to populate fields on the forms. ([0123], lines 1-3)

18. In regards to **Claim 17**, YERS discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, wherein the forms are customized according to client characteristics. ([0074])

19. In regards to **Claim 18**, YERS discloses:

In a client-server environment, a user interface provided by a server for facilitating the management of human resources compliance efforts, further including an interface portion configured to display training materials and to track training progress. (Figures 6A-9D)

20. **Claims 19-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Your Exall et al. (Patent No. US 7330,817 B1) (hereafter referred to as Exall).

21. In regards to **Claim 19**, Exall discloses:

In a server system that is in communication with a client system and that has a user interface and access to a store of human resources forms, a method for facilitating management of human resources compliance efforts, the method comprising:

(a) receiving a request from a client to access at least one of a plurality of human resources forms available to the server system; (Fig. 3 and column 4, line 50)

(b) displaying the requested at least one human resources forms at the client system, the requested at least one human resources forms requesting client status data; (Fig. 3 and column 15, lines 64-65)

(c) receiving client status data that is entered on the at least one human resources forms at the client system; (Fig. 3 and column 15, lines 64-65) and

(d) displaying at least one additional human resources forms in an order that is dynamically controlled at least in part by a legal criteria and the entered client status data, at least one of the receiving and displaying processes being performed in connection with the user interface. (Fig. 3 and column 2, lines 25-35)

22. In regards to **Claim 20**, Exall discloses:

In a server system that is in communication with a client system and that has a user interface and access to a store of human resources forms, a method for facilitating management of human resources compliance efforts, further including updating the at least one human resources forms or the at least one additional human resources forms in response to a change in the legal criteria. (column 4, lines 62-67 and column 5, lines 1-7)

23. In regards to **Claim 21**, Exall discloses:

In a server system that is in communication with a client system and that has a user interface and access to a store of human resources forms, a method for facilitating management of human resources compliance efforts, further including generating and

displaying a notice at the client system that notifies the client of the change in the legal criteria. (column 4, lines 54-67 and column 5, lines 1-7)

24. In regards to **Claim 22**, Exall discloses:

In a server system that is in communication with a client system and that has a user interface and access to a store of human resources forms, a method for facilitating management of human resources compliance efforts, wherein the requested client status data comprises input regarding an applicant for hire. (Fig. 3; column 15, lines 64-65; and column 31, lines 19-20, lines)

### ***Claim Rejections - 35 USC § 103***

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

27. **Claim 2** is rejected under 35 U.S.C. 103(a) as being unpatentable over YERS as applied to claim 1 above.

28. In regards to **Claim 2**, YERS discloses:

YERS discloses all of the above limitations. Additionally YERS discloses wherein forms related to the screening of applicants and the hiring of employees are made available (YERS, page 1, ¶ 3), but YERS does not disclose the specific forms that are provided (a first rejection letter form, a second rejection letter form, a conditional acceptance letter form, a drug screening authorization form, background screening authorization form, a third rejection letter form, an intent-not-to-hire letter form, and a new hire document).

However, It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have included these or similar forms as available resources since the actions they represent are common among human resource functions.

29. **Claims 8-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over YERS in view of Exall.

30. In regards to **Claim 8**, YERS does explicitly disclose that the status information is received from the client, however, Exall discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein generating the human resources compliance forms includes receiving the status data from the client. (column 32, lines 19-20 and 32-35)

31. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of YERS so as to have included receiving the status data from the client taught by Exall in order to Make sure the information is accurate and up to date, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

32. In regards to **Claims 9 and 10**, YERS does explicitly disclose that the status information is received from a third party, however, Exall discloses:

In regards to **Claim 9**, YERS discloses:

In a client-server environment, a method for facilitating the management of human resources compliance efforts, wherein the status data is received from a third party resource. (column 9, lines14-21)

33. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of YERS so as to have included receiving the status data from a third taught by Exall in order to Make sure the information is accurate, timely and up to date, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. S./  
Examiner, Art Unit 4176  
June 3, 2008

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 4176